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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/087,975	03/01/2002	Yakov Kamen	ISURFTV164	9048

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HOLLAND & KNIGHT LLP
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131 S. DEARBORN STREET
30TH FLOOR
CHICAGO, IL 60603

EXAMINER

PENG, FRED H

ART UNIT	PAPER NUMBER
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2623

MAIL DATE	DELIVERY MODE
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06/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/087,975

Applicant(s)

KAMEN ET AL.

Examiner

Fred Peng

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03/10/2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 2623

DETAILED ACTION

Response to Arguments

1. Applicant's arguments with respect to claims 1-24 have been considered but are moot in view of the new ground(s) of rejection.

In response to the applicant's arguments on page 7 of 03/10/2007 Remarks, the applicant argues that reference of Saib teaches only jump button but not numeric channel selection button.

The examiner respectfully disagrees with applicant's arguments. Saib does teach numeric channel selection button with the jump button which jumps to (selects) different channels (numerical channels) based on the depression duration of jump button (FIG.3; FIG. 4A-4D).

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claims 10-18 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 10-18 are drawn to functional descriptive material recorded on a machine readable-medium. Normally, the claim would be statutory. However, the specification, at page 8, paragraph 23 defines the claimed computer readable medium as encompassing statutory media such as a "magnetic disk storage media", "optical storage media", ROM", etc, as well as *non-statutory* subject matter such as a "data signals embodied in a carrier wave or other propagation medium".

A "signal" embodying functional descriptive material is neither a process nor a product (i.e., a tangible "thing") and therefore does not fall within one of the four statutory classes of § 101. Rather, "signal" is a form of energy, in the absence of any physical structure or tangible material.

Art Unit: 2623

Because the full scope of the claim as properly read in light of the disclosure encompasses non-statutory subject matter, the claim as a whole is non-statutory. The examiner suggests amending the claim to include the disclosed tangible computer readable media, while at the same time excluding the intangible media such as signals, carrier waves, etc defined in the specification. Any amendment to the claim should be commensurate with its corresponding disclosure. **For example, in claim 10, the phrase "A machine – readable medium" should be changed to**

-- A computer – readable memory --. And all recitations of "machine" should be changed to --computer--.

Any amendment to the claim should be commensurate with its corresponding disclosure.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent; except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1-5, 7, 10-14, 16 and 19-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Saib (US 2001/0005905 A1).

Regarding Claims 1, 10 and 19, Saib discloses an apparatus (FIG.2) with corresponding method and machine-readable medium (FIG.2, -37) comprising:

a processor (FIG.2, -29) having a memory (FIG.2, -37) coupled thereto, the memory having stored thereon executable instructions which, when executed by the processor, cause the processor to evaluate a depression duration of a numeric channel selection button, the button controlling a multimedia presentation device, and perform a function of a plurality of functions

Art Unit: 2623

upon the based upon the depression duration (FIG.3; Para 6 lines 1-2; Para 32 lines 1-5; Para 28 lines 1-8).

Regarding Claims 2, 11 and 20, Saib further discloses evaluating the depression duration comprises:

determining depression of button; periodically incrementing a counter during the depression duration; and evaluating the counter value, upon termination of the depression of a button (Para 28 lines 1-3; Para 31 lines 6-10; Para 28 lines 5-7; Para 28 lines 8-12; The CPU acting as a computer function is inherent to perform the counter functionality and evaluate the value).

Regarding Claims 3, 4, 12, 13, 21 and 22, Saib further discloses some of the plurality of functions affect a favorite channel list, each channel positioned in the list arbitrarily, wherein functions affecting the favorite channel list are selected from the group consisting of accessing, updating, programming and last channel (Para 36 lines 7-10; Para 37 lines 1-3; Para 6 lines 5-13; Para 5 lines 2-6).

Regarding Claims 5 and 14, Saib discloses a method with corresponding machine-readable medium comprising:

implementing a plurality of functions on a multimedia presentation device; and providing access to the plurality of functions through a single-button depression scheme of a numeric channel selection button wherein a button depression duration corresponds to one of the plurality of functions (Para 16 lines 1-7; Para 6 lines 1-2; Para 32 lines 1-5; Para 6 lines 7-13; Para 35 lines 13-21).

Regarding Claims 7 and 16, Saib further discloses the plurality of functions affect a favorite channel list (Para 35 lines 13-21).

Art Unit: 2623

Regarding Claim 23, Saib discloses a multimedia presentation device comprising:

a television display; a push-button control device to control the television display, the push-button control device providing access to a plurality of functions through a single-button depression scheme of a numeric channel selection button wherein button depression duration corresponds to one of the plurality of functions (Para 18 lines 1-6); and

a favorite channel list, the favorite channel list containing a plurality of pre-settable program selections arbitrarily selected by a user (Para 21 lines 5-9).

Regarding Claim 24, Saib further discloses one of the plurality of functions is a last channel function, the last channel function allowing the user to select a succession of previously-tuned channels from the favorite channel list (Para 6 lines 1-7).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 8-9 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saib (US 2001/0005905 A1) in view of Burgett et al (US 5,982,357).

Regarding Claims 8-9 and 17-18, Saib discloses implementing a function of plurality of functions on a multimedia presentation device and providing access to the plurality of functions through a single-button depression wherein a button depression duration corresponds to one of the plurality of functions by (Para 16 lines 1-7, Para 6 lines 1-2, Para 32 lines 1-5, Para 6 lines 7-13, Para 35 lines 13-21).

Art Unit: 2623

Saib fails to disclose button depression duration and a function is based upon an expected use frequency of the function, more frequent use function corresponding to longer period depression.

In an analogous art, Burgett discloses button depression duration and a function is based upon an expected use frequency of the function (Col 4 lines 47-51).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saib's method with a function is based upon an expected use frequency of the function, as taught by Burgett as a conventional and intuitive way to define the function.

8. Claims 6 and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saib (US 2001/0005905 A1) in view of Journot (US 4,052,799).

Regarding Claims 6 and 15, Saib discloses corresponding function indicator relates to each depression duration (Para 29 lines 1-8).

Saib fails to disclose depression duration indicator indicating a time of depression.

In an analogous art, Journot discloses depression duration indicator indicating a time of depression (Col 2 lines 51-54).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saib's system with a depression duration indicator and a corresponding function, as taught by Burgett as an aided tool to verify the depression function.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred Peng whose telephone number is (571) 270-1147. The examiner can normally be reached on Monday-Friday 08:30-18:00.

Art Unit: 2623

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Grant can be reached on (571) 272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred Peng
Patent Examiner

Chris Grant
Supervisory Patent Examiner

A handwritten signature in black ink, appearing to read 'Chris Grant', is positioned above the printed name and title.

**CHRISTOPHER GRANT
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600**